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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,445	11/20/2000	Warren Adams	249768040US	2880

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EXAMINER

JASMIN, LYNDIA C

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/718,445

Applicant(s)

ADAMS ET AL.

Examiner

Lynda Jasmin

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 and 44-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-43 and 67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Amendment received September 22, 2003 has been acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 25-28, 31, 33-39, 41-43 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (6,611,814 B1) in view of Nelson et al. (200/0042775 A1).

Lee et al. discloses a method in a computing system (via an online store) for notifying a first user (via recipient 140 which is also a shopper allowing other

Art Unit: 3627

shoppers and online store to use their wish list) about a purchase made by a second user (shoppers 101 which could also be a list owner), including: detecting that the second user has purchased an item (via checkout process step 216; tracking device 1406, as illustrated in another embodiment), determining that the first user (recipients 140) has a purchase notification relationship with the second user (shoppers 101) established independently from the purchase of the item by the second user (via virtual wish list provider 130; col. 9, lines 33-41).

Lee et al. further discloses receiving an order from the second user for the item (via checkout process, col. 13, lines 11-12), receiving an order from a third user (via another shopper) ordering the item as a gift for the second user (col. 12, lines 18-21). Lee et al. also discloses establishing for the first user a purchase notification relationship with the second user in response to an instruction from the first/second user (via the creation of a recipient list of which owns wish list on the server), and establishing for the first user a purchase notification relationship with the second user in response to a comparison of characteristics of the first and second users (col. 6, lines 19-35).

As per claim 43, Lee et al. further discloses the purchase detection subsystem (via the checkout process step 216) detects that the second user has purchased an item for a recipient other than the first user (since one or more persons are on the recipient list 702 via receivers 140) (further, as illustrated in Figure 8, the shopper 101, viewed as the second user, can make transactions for purchasing one or more product from their owned wish list) (col. 12, lines 12-26), a purchase notification relationship subsystem (via online store 120) that

Art Unit: 3627

determines that the first user has a purchase notification relationship with the second user (col. 6, lines 42-53).

However, Lee et al. fails to explicitly disclose providing to the first user a notification that the second user has purchased the item, and receiving input from the second user indicating that the second user owns the item.

Nelson et al. discloses the concept of notifying to a recipient of purchased made by a purchaser (114). The notifying concept is via gift card electronically generated and sent in an email message, or a physical gift card provided (such as via postal mail gift card). Nelson et al. further discloses an input via payment mechanism that the purchaser has paid for the transaction and an invoice is generated. Nelson et al further discloses determining if an initial payment is required for the commodity before completed the process of registering for a registry which could be viewed as the recipient being also the purchaser by making a down payment for the commodity. List of items either available or unavailable can be viewed at client computer (122) via exchanging information with server computer (126).

From this teaching of Nelson et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modify the users online store and wish list of Lee et al. to include notifying of the receiving user as taught by Nelson et al. in order to indicate that a product has been purchased and thereby delay it from a wish list.

Art Unit: 3627

5. Claims 29, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. in view of Nelson et al., and further in view of Ewing (202/0095298 A1).

The Lee et al. and Nelson et al. combination discloses all the elements of the claimed invention but fail to explicitly disclose the common an well known variation of sending messages via instant message, pager message and voice mail message.

Ewing discloses the concept of having member interacting with other members over the internet using text, audio or voice chat; instant messaging; or, e-mail, and the member desires to send the other member a gift.

From this teaching of Ewing, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modify the Lee et al. and Nelson et al. combination to include the different ways of sending notification message to another party as taught by Ewing in order to engage in real time conversation.

Response to Arguments

6. Applicant's arguments with respect to claims 25-43, and 67 have been considered but are moot in view of the new ground(s) of rejection. As per Applicants request, the following portions of Nelson et al. used by the Examiner are found on page 2, line 29-30, page 7, lines 17-29, page 10, lines 16-21 and page 12, lines 13-24 and also as illustrated in Figure 1 via the notification from the server to the recipient 110 in the provisional application.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Garrett and Chislenko et al. are cited for disclosing of recommending list of items to users.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda C Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

Art Unit: 3627

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.


Lynda Jasmin
Examiner
Art Unit 3627
11/13/03

lj